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In re Application of
Powell, Cmelik, Kong, Ditzel
and Kelly
Application No. 08/887,680
Filed: July 3, 1997
For: Extending Computer
Architecture from 32-Bits to
64-Bits

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:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
:

This is in response to the petition under 37 CFR 1.47(b),
filed December 19, 1997, which has been treated as a petition
under 37 CFR 1.47(a).¹

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date
of this decision to reply, correcting the below-noted
deficiencies. Any reply should be entitled "Request for
Reconsideration of Petition Under 37 CFR 1.47(a)," and should
only address the deficiencies noted below, except that the
reply may include an oath or declaration executed by the non-
signing inventor. Failure to respond will result in
abandonment of the application. Any extensions of time will
be governed by 37 CFR 1.136(a).

The above-identified application was filed on July 3, 1997
without an executed oath or declaration.

Accordingly, on October 1, 1997, a "Notice to File Missing
Parts of Application" was mailed, requiring an executed oath
or declaration and an assent of the assignee, and a surcharge
for their late filing.

In response, on December 19, 1997, a petition under 37 CFR
1.47(b) was filed. In the petition, Mr. Hyman, an attorney
representing Sun Corporation, states that Powell, Cmelik,
Kong, Ditzel and Kelly are the joint inventors in the above-
identified application and that all of the joint inventors

¹A petition under 37 CFR 1.47(b) is inappropriate in this
instance since at least one of the inventors has signed the
declaration. A petition under 37 CFR 1.47(b) is only appropriate
where none of the inventors will sign, accordingly the petition
will be treated as a petition under 37 CFR 1.47(a).

were presented with a copy of U.S. Patent No. 5,430,864, upon which the reissue is based, new claims 17-38 and the declaration and power of attorney form. Mr. Hyman further explains that Powell, Cmelik, Ditzel and Kelly never returned an executed declaration. Furthermore, Mr. Hyman states that a copy of the letter forwarding the application to the inventors is attached as Exhibit 1 and a copy of the assignment of patent rights to Sun Corporation is attached as Exhibit 2. However, upon review of the file, no such exhibits were found. In addition, a "Combined Declaration and Power of Attorney" signed by Shing Kong, one of the inventors, was filed with the petition. Furthermore, another "Combined Declaration and Power of Attorney" signed by Mr. Kenneth Olsen was filed. This declaration fails to state in what capacity Mr. Olsen is signing the declaration.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) and (2) as set forth above.

As to item (1), the petition does not clearly establish that the non-signing inventors have refused to sign the declaration. Unless the non-signing inventors were presented with a copy of the application papers (specification, claims and drawings), the non-signing inventors could not attest that they have "reviewed and understood the application papers" and therefore could not sign the declaration which they were given. Accordingly, the petitioner has failed to clearly show or provide clear proof that the non-signing inventors have refused to sign the declaration. See Manual of Patent Examining Procedure (MPEP), Section 409.03(d). Petitioner should show that a copy of the application papers was presented to each inventor, but that they did not respond to the request that they sign the oath/declaration in order to show that the inventor has refused to join in the application. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events and should include documentary evidence such as certified mail return receipt, cover letter of instructions, telegram, etc.

As to item (2), the declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been

presented. 37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, requires all available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP § 602, § 605.01, and §1414) and (2) make oath or declaration on behalf of the non-signing joint inventor as required by 37 CFR 1.64. The declaration in the above-identified application is unclear if Mr. Kong signed the declaration on behalf of Powell, Cmelik, Ditzel and Kelly because of the additional declaration signed by Mr. Olsen. From statements in the instant petition, it appears that Mr. Olsen is signing on behalf of all the inventors and on behalf of Sun Corporation. Additionally, the declarations signed by Kong and Olsen are not in full compliance with 37 CFR 1.63 because the declarations identify the above-mentioned application with the wrong serial number. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by Mr. Kong on behalf of himself and on behalf of Powell, Cmelik, Ditzel and Kelly is REQUIRED. See MPEP 409.03(a).

Additionally, counsel's deposit account No. 02-2666, will be charged the required \$130 petition fee. Petitioner's attorney Eric Hyman gave written authorization to charge the deposit account in the instant petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned or Legal Advisor Jeanne Clark at (703) 305-9285.



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Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
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